

REMARKS

Claims 1-8 are pending in the instant application. In the most recent Office Action, claims 1-8 are rejected under 35 USC § 103(a) as allegedly obvious over PCT Publication WO 99/26394 by Borland (hereinafter, "Borland") in view of Japanese Patent Abstract 10-042 036-A by Morita (hereinafter, "Morita"). Applicant respectfully traverses the rejection, for at least the reasons set forth below.

Claim 1 recites a portable telephone with an originator acknowledge function, the portable telephone comprising, *inter alia*, a channel control means for activating a response control means and connecting the channel in originator confirmation mode when the originator confirmation button is operated. The Office Action avers this feature to be taught in Borland at p. 3, lines 6-14. However, in contrast to the claim, the cited passage of Borland describes only a telephone system that emits a distinctive ring depending on the intended callee. Therefore, claim 1 will be seen as distinguished over Borland.

Regarding Claim 2, the Office Action avers that Borland teaches at p. 15, lines 5-18, timer means for measuring a predetermined time after the first message is sent. The first message sent refers to sending a first message prompting a response of an originator. However, in contrast to the claimed invention, Borland does not use a timer means, nor measures elapsed time from a first message to the originator. Rather, Borland teaches that the telephone emits a message to the intended recipient of the call, identifying the caller and the callee. After five iterations ("five times"), the telephone reroutes the call, or disconnects the line, irrespective of the time that has elapsed. Moreover, the initiating event of the iteration counter in Borland is not a message sent to the originator of the call, but instead and announcement of the incoming call to

the intended recipient. Therefore, claim 2 will be seen as further distinguished over Borland.

Claim 3 further recites timer means for measuring a predetermined time after the originator confirmation mode starts. As shown above, the initiating event and the terminating criteria of Borland are different from the function recited in the claim. Therefore, claim 3 will similarly be seen as further distinguished over Borland.

Claim 4 further recites a channel disconnection button. The Office Action avers that this feature is taught at p. 18, lines 1-5. However, in contrast to the claimed invention, Borland does teach or suggest a channel disconnect button. Rather, Borland teaches that after hearing a caller announce himself, the caller has the option of taking the call, either in speakerphone mode or conventionally with a handset, or may do nothing, allowing the telephone system to dispose of the call, by forwarding the call to an answering machine. Therefore, claim 4 will be seen as further distinguished over Borland.

Claims 5-7 each depend, either directly or indirectly, from claim 1. They are each separately patentable, but are offered as patentable for at least the same reasons as underlying independent claim 1.


Claim 8 recites a portable telephone with an originator acknowledge function, the portable telephone comprising, *inter alia*, channel connection means for connecting a channel in accordance with an operation of said originator confirmation button and response button in terminating operation. As illustrated above, with respect to claim 1, Borland does not teach a channel connecting means as recited in the claim. Therefore, claim 8 will be seen as distinguished over Borland.

Morita is offered only for its teaching that a telephone may be a portable telephone. It offers nothing to ameliorate the deficiencies of Borland with respect to the claims as illustrated

above. Further, Applicant respectfully disagrees that Borland and Morita may properly be combined to form a *prima facie* case that the claimed invention is obvious. However, notwithstanding the combinability of the references, all the claim limitations must be taught or suggested by the prior art to establish *prima facie* obviousness. See, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Borland nor Morita, taken alone or in any combination, neither teach nor suggest all claim limitations. Therefore, Applicant respectfully submits that the claims are patentably distinguished over the references.

In light of the foregoing, Applicant respectfully submits that all claims recite patentable subject matter, and kindly solicits an early indication of allowability. If the Examiner has any reservation in allowing the claims, and believes that a telephone conference would advance prosecution, he is kindly requested to telephone the undersigned at his earliest convenience.

Respectfully Submitted,



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